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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,335

07/01/2004

David S. Bonalle

70655.3200

4334

66170 7590 04/19/2007

AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC.

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/710,335		BONALLE ET AL.	
	Examiner		Art Unit	
	Daniel I. Walsh		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the RCE received on 1-13-07 and the IDS's received on 2-20-07.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4, 6, 9-13, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209) in view of Hoshino (US 6,636,620).

Black teaches detecting a proffered biometric at a sensor communicating the system to obtain a proffered biometric sample; verifying the proffered biometric sample, and authorizing a

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transaction (FIG. 1C). The Examiner notes that though silent it is understood that data is generated of the sample and that the sample is verified to authorize a transaction.

Black is silent to using the sample as a variable in an encryption calculation to secure at least one of user and transaction data.

Hoshino teaches encryption (see claim 3).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Hoshino.

One would have been motivated to do this for security.

Re claim 4, Black teaches the step of detecting includes detecting a proffered biometric at a sensor configured to communicating with the system via at least one of a smartcard, reader, and network (FIG. 1C). Re claim 6, Hohle et al. teaches such limitations (FIG. 4). Re claim 7, though silent to public/private keys, as encryption has been discussed above, the Examiner notes that public/private key encryption is well known and conventional in the art and an obvious expedient for security while maintaining ease of use and acceptability. Black teaches that samples are logged/stored (transaction record paragraph [0126]). The Examiner also notes it's an obvious expedient to keep a log/record of transactions and associated data/information for record keeping purposes. Such logging/recording is conventional with credit card transactions where a signature is captured and stored in addition to credit card numbers, and therefore simply logging the biometric data, which is used for enhanced security, is an obvious expedient. Re claim 8, FIG. 1C teaches detecting/processing/storing at least one second proffered biometric sample (as both the electronic and digital signatures are captured). Re claim 9, FIG. 1C teaches comparing a proffered sample with a stored sample for verification. Re claim 10, Black teaches

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that a comparison between a proffered biometric sample and stored biometric samples includes comparing samples with a sample of at least one of a criminal, terrorist, and card member (FIG. 1C), as it is obvious that a proffered biometric is compared to card members to verify that the biometric matches the card member. Re claim 11, the Examiner notes that Black teaches embodiments where the biometric data can be stored on the portable device itself, or remotely (paragraph [0090] +). Accordingly, based upon the desired security, verifying the sample could either use information contained on at least one of a local database, remote database, and a third party controlled database. For example, in the case where the information is stored remotely, the Examiner notes it would have been an obvious expedient to store the information in a database, since databases are well known and conventional in the art, for storing and arranging data that can be fetched and accessed quickly and reliably. Therefore, storing the information on a database is an obvious expedient. Re claim 12, Black teaches the device is configured to verify/authenticate an individual for purchasing of goods (abstract), which is broadly interpreted as simultaneous access and initiation of authenticating, such when goods are accessed at purchasing.). Though Black in some embodiments is drawn to an RFID/transponder, the Examiner notes that Black states that such teachings can apply to smartcards as well (abstract). Re claim 13, a sensor has been discussed above re Black.

Though Black/Hohle et al. are silent to notifying a user to proffer a biometric sample (audibly/visually/mechanically/etc. re claim 3) the Examiner notes that it is well known and conventional to provide instructions/notifications to a user engaged in a card transaction, in order to guide them to facilitate completion of the transaction. This is especially well known and

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conventional with standard credit card transactions where a user interfaces with a terminal that displays instructions to the user.

Re claim 16, the teaching of a transaction limitation being a maximum amount, has been discussed above, re claim 1.

Re claim 18, though silent to a government agency or vendor, Black above teaches remote storing of the sample. It would have been an obvious expedient to store at a government agency or vendor, to facilitate security of the stored samples.

3. Claims 5, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hoshino, in view of Hohle et al.

The teachings of Black/Hoshino have been discussed above.

Black/Hoshino is silent to the details of the file structures as claimed.

Hohle et al. teaches such limitations (see claim 1). It is clear that the file structure is used for transactions. Hohle et al. teaches biometrics, as well.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hoshino with those of Hohle et al.

One would have been motivated to do this for convenience for the user (consolidation of applications).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hoshino, as discussed above, in view of Brandys (US 2002/0186838).

The teachings of Black/Hoshino, including encryption, have been discussed above.

Black/Hoshino are silent to private/public keys.

Brandys teaches such limitations (abstract).

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At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hoshino with those of Brandys.

One would have been motivated to do this based on security concerns.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hoshino, as discussed above, in view of Hohle et al.

The teachings of Black/Hoshino have been discussed above.

Black/Hoshino is silent to the MAC as claimed.

Hohle et al. teaches such limitations (col 22, lines 47+).

One would have been motivated to combine the teachings of Black/Hoshino with those of Hohle et al.

One would have been motivated to do this for security concerns.

6. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hoshino, as discussed above, in view of de Sylva (US 2005/0098621).

The teachings of Black/Hoshino have been discussed above.

Black/Hoshino are silent to a PIN in addition to a biometric, and facilitating selection of an account from two accounts.

The Examiner notes that the use of secondary security procedures, PIN, passcodes, etc. are obvious in the art to supplement security in a system. Along those lines, de Sylva teaches a PIN (paragraph [0030]) and facilitating selection of an account through account records 30, which selects accounts based on user preferences.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hoshino with those of de Sylva.

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One would have been motivated to do this for additional security and for permitting user preferences to be involved in the transaction.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hoshino, as discussed above, in view of Wallace (US 5,988,497).

The teachings of Black/Hoshino have been discussed above.

Black/Hoshino are silent to a second sample to override a transaction limitation.

Wallace teaches multiple tiers of authentication in order to authenticate a transaction that meets certain conditions (abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hoshino with those of Wallace.

One would have been motivated to do this to provide more authentications for certain transactions, as it is known that additional samples can provide more security. The replacing of additional PINs of Wallace, by biometrics of Black is an obvious expedient to provide more secure transactions.

Response to Arguments

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: (see attached PTO-892), noting Jensen et al. teaches secondary security features to authorize transactions of a certain amount, as conventional in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
4-9-07



DANIEL WALSH
PRIMARY EXAMINER